

REMARKS

Claims 1-21 are pending. Claims 18-21 have been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Status of the Claims

Claim 7 was objected to.

Claims 1-17 were rejected pursuant to 35 U.S.C. § 112, second paragraph.

Claims 1-27 [sic] were rejected pursuant to 35 U.S.C. § 101.

Claim 1 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Graef (US 4,494,747) in view of Davidson (US 5,769,410).

Claims 2-6 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Graef in view of Davidson and Svyatsky (US 4,607,833).

Claims 7-17 were not rejected on prior art but only rejected pursuant to 35 U.S.C. § 101. MPEP § 706.01. These claims are presumed by Applicants to be objected to as being dependent upon a rejected base claim, but would otherwise be allowable if written in an independent form while overcoming the base claim rejection and the 35 U.S.C. § 101 rejection. The Office's inferred indication of allowable subject matter is appreciated.

Objection to the disclosure

The language "should appear" in 37 CFR 1.77(c) is not a requirement but merely a suggestion for the "preferable" manner of framing a specification, as evidenced by MPEP 608.01(a) (Rev. 3, August 2005, page 600-72, col. 1). Applicants respectfully decline the invitation to amend the section headings.

The typographical errors regarding shaft 248 and tab portion 270 have been corrected. The Examiner's notice thereof is appreciated.

The Drawing objections

One skilled in the art would understand that the reference characters 154 and 164 do not designate the *same* part in Figure 9. The specification is clear that the cam 154 is bounded by a cam surface 164 (e.g., page 22, line 17). This is further evidenced by Figures 7 and 10.

One skilled in the art would understand that the reference characters 94 and 80 do not designate the *same* part in Figure 10. The specification is clear that the picking member 72 has an outer bounding surface 80 (e.g., page 17, line 1; Figures 2-3). The specification is also clear that the picking member 72 has a shaft 88 and three separated cylindrical portions (central portion 90, first outboard portion 92, and second outboard portion 94) are supported on the shaft (e.g., page 19, lines 7-14; Figures 2-3). Figure 10 shows the outer surface of segment 144 moved to generally conform with the outer bounding surface 80 of the picking member 72. Figure 10 also shows outboard portion 94.

Reference character 216 (Figure 18) has support in the specification. For example, note page 28, line 15 and page 29, line 20.

Reference character 277 (Figure 18) has been provided at page 37, line 4. The Examiner's notice of the typographical error is appreciated.

The claim 7 objection

The typographical error in claim 7 was corrected as requested by the Office. The Examiner's notice thereof is appreciated.

The 35 U.S.C. § 112, second paragraph rejections

The Applicants respectfully disagree with the rejections. The rejection is unclear. The claims are method claims. The Office objects to "apparatus limitations" yet recommends reciting these same "apparatus limitations". Claim 1 is already directed to deforming a tab portion and engaging a picking shaft. Therefore, why the Office recommended an additional (unnecessary) step directed to "providing a tab portion and a picking shaft" is unclear.

The 35 U.S.C. § 101 rejections

Claims 1-27 were rejected pursuant to 35 U.S.C. § 101. Since only claims 1-17 were pending at the time of rejection, Applicants presume that only claims 1-17 are rejected.

The Applicants respectfully disagree with the rejections. The claims are method claims. Claim 1 recites positive active steps, such as deforming a tab portion and engaging a picking shaft. It is unclear how the claims can be construed as apparatus claims. Note "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", 1300 Off. Gaz. Pat. Office 142 (Nov. 22, 2005).

The 35 U.S.C. § 103 rejections

Claim 1

The Office admits that Graef does not teach or suggest any recited step. Likewise, Graef appears to teach against the recited invention.

Davidson is non analogous art. Davidson is directed to an "electrophotographic printing machine" (col. 1, lines 4-8). How is Davidson analogous to the environment of a "cash dispensing automated banking machine"?

The Action alleges that Davidson's spring (208) constitutes a resilient tab portion. However, the Action is silent regarding Davidson's own differentiation between a spring (208) and a tab (212).

The Office also has not explained how Davidson's spring (208) is "on a housing". The Action is silent as to what constitutes the "housing" in Davidson.

Nevertheless, even if it were somehow possible for Davidson's spring (208) to constitute a resilient tab portion as alleged, Davidson still would not teach or suggest the tab/picking shaft first end and drive shaft/picking shaft second end relationships. First, the alleged tab (208) is associated with the *drive* shaft (209), not the alleged *picking* shaft (210) (col. 5, lines 8-9). Where does Davidson show a tab portion at an end of a picking shaft? Second, at best the alleged tab (208) and the drive shaft (209) are each adjacent the *same* end of the picking shaft (210), not at opposed first and second ends. Where does Davidson show both a tab portion at a first end of a picking shaft and a drive shaft at the second end of the picking shaft?

Nor has the Office explained how Graef could be modified to have produced the recited invention, especially without destroying the disclosed utility and operability of the Graef

apparatus. An obviousness rejection cannot be based on a combination of features that would result in destroying the utility or advantage of the device taught in Graef. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

The attempts to modify Graef are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicants' disclosure.

The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest all of the recited features, relationships, and steps. Nor would it have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention.

Claims 18 and 20

For reasons of brevity, Applicants' previous remarks regarding the patentability of claim 1 are incorporated herein by reference. The references, taken alone or in combination, do not teach or suggest the recited features, relationships, and steps.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The Applicants have shown the independent claims to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis. Furthermore, each dependent claim additionally recites specific features and relationships that further patentably distinguish the claimed invention over the applied art.

The references do not teach or suggest the features and relationships that are specifically recited in these claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Fee For Extra Total Claim

Please charge the fee associated with the submission of one excess total claim (\$50) and any other fee due to Deposit Account 09-0428.

Conclusion

Applicants respectfully submit that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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